

REMARKS

In the office action dated 10/05/2004, claims 1-15 were examined.

By way of the office action claims 2, 3, 4, 13 and 14 stand rejected under 35 U.S.C. first paragraph as being indefinite.

By way of the office action claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Habib et al., U.S. Patent No. 5,825,356.

In response, claim 1 has been non-narrowingly edited to avoid Festo-like implications, claims 2-14 have been amended, claim 15 has been canceled, and new claims 16-21 have been added. Accordingly, claims 1-14 and 16-21 are now pending in the present application.

Indefinites.

Claims 2, 3, 4, 13 and 14 have been amended in order to improve the clarity as requested by the outstanding office action.

Claims 1-14 are Allowable.

Claim 1 stands rejected under 35 U.S.C. 102(b) as being unpatentable over Habib.

Claim 1 has been amended for encompassing subject matter disclosed in the original specification as filed (see for reference page 3, line 23 – page 5, line 5).

Claim 1 relates to a method of producing various types of articles using a same automatic machine, which comprises a number of operating devices controlled by a control unit. Habib relates to a software for a personal computer having an on-screen help program. In our opinion, the software disclosed by Habib cannot be considered as included in a field analogous to that of the application in object, because the structural characteristics and the required performances of an automatic machine for producing articles (which has to be installed in a production facility and has to be used by professional users) are completely

different from those of a software for a personal computer. Furthermore, an automatic machine for producing articles and a software for a personal computer clearly belong to absolutely distinct technical and economical sectors. Owing to the above, the skilled man in the automatic machine field would never look for a solution in the personal computer software field.

Several US courts decision* (cited below) stated that prior art for obviousness cannot include items in non-analogous fields, and arts are analogous if one seeking to solve a problem in one art would likely look for a solution in the other art. Owing to the above, we believe that Habib cannot be used for evaluating the obviousness of the application in object.

* *Wood*, 599 F.2d 1032, 202 U.S.P.Q. 171 (CCPA 1979)

* *King Instrument Corp. V. Otari Corp.*, 767 F.2d 853, 226 U.S.P.Q. 402 (Fed. Cir. 1985)

* *Shapleigh*, 248 F.2d 96, 115 U.S.P.Q. 129 (CCPA 1957)

* *Murphy*, 217 U.S.P.Q. 479 (PTO Bd. App. 1976)

35 U.S.C. 103 Conditions for patentability

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The subject matter of the application in object pertains to the automatic packing machines, Habib relates to a software for a personal computer.

MPEP 2141.01(a) Analogous and Nonanalogous Art

TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

PTO CLASSIFICATION IS SOME EVIDENCE OF ANALOGY, BUT SIMILARITIES AND DIFFERENCES IN STRUCTURE AND FUNCTION CARRY MORE WEIGHT

While Patent Office classification of references and the cross-references in the official search notes are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (The structural similarities and functional overlap between the structural gratings shown by one reference and

the shoe scrapers of the type shown by another reference were readily apparent, and therefore the arts to which the reference patents belonged were reasonably pertinent to the art with which appellant's invention dealt (pedestrian floor gratings).); In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992) (Claims were directed to a process for storing a refined liquid hydrocarbon product in a storage tank having a dead volume between the tank bottom and its outlet port wherein a gelled solution filled the tank's dead volume to prevent loss of stored product while preventing contamination. One of the references relied upon disclosed a process for reducing the permeability of natural underground hydrocarbon bearing formations using a gel similar to that of applicant to improve oil production. The court disagreed with the PTO's argument that the reference and claimed inventions were part of the same endeavor, "maximizing withdrawal of petroleum stored in petroleum reserves," and found that the inventions involved different fields of endeavor since the reference taught the use of the gel in a different structure for a different purpose under different temperature and pressure conditions, and since the application related to storage of liquid hydrocarbons rather than extraction of crude petroleum. The court also found the reference was not reasonably pertinent to the problem with which the inventor was concerned because a person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for refined petroleum by considering a reference dealing with plugging underground formation anomalies.).

ANALOGY IN THE MECHANICAL ARTS

See, for example, In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (Applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference

which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The Commissioner further argued in the brief on appeal that a disengageable catch is a common everyday mechanical concept, however the court held that the Commissioner did not explain why a "catch" of unstated structure is such a concept, and why it would have made the claimed invention obvious.). Compare *Stevenson v. International Trade Comm.*, 612 F.2d 546, 550, 204 USPQ 276, 280 (CCPA 1979) ("In a simple mechanical invention a broad spectrum of prior art must be explored and it is reasonable to permit inquiry into other areas where one of ordinary skill in the art would be aware that similar problems exist.").

Also see *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986) (Applicant's claims related to double-acting high pressure gas transmission line compressors in which the valves could be removed easily for replacement. The Board relied upon references which taught either a double-acting piston pump or a double-acting piston compressor. The court agreed that since the cited pumps and compressors have essentially the same function and structure, the field of endeavor includes both types of double-action piston devices for moving fluids.); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (Claims at issue were directed to an instrument marker pen body, the improvement comprising a pen arm holding means having an integrally molded hinged member for folding over against the pen body. Although the patent owners argued the hinge and fastener art was nonanalogous, the court held that the problem confronting the inventor was the need for a simple holding means to enable

frequent, secure attachment and easy removal of a marker pen to and from a pen arm, and one skilled in the pen art trying to solve that problem would have looked to the fastener and hinge art.); and Ex parte Goodyear Tire & Rubber Co., 230 USPQ 357 (Bd. Pat. App. & Inter. 1985) (A reference in the clutch art was held reasonably pertinent to the friction problem faced by applicant, whose claims were directed to a braking material, because brakes and clutches utilize interfacing materials to accomplish their respective purposes.).

Accordingly, claim 1 is allowable. Claims 2-14 depending from claim 1 are also allowable.

Claim 16 is Allowable.

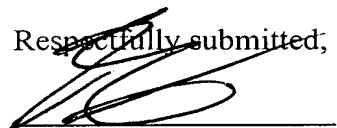
Claim 16 encompasses the subject matter of original claim 15 and also subject matter disclosed in the original specification as filed (see for reference page 3, line 23 – page 5, line 5).

Claim 16 recites substantially the same subject matter of amended claim 1, thus what above said in relation to amended claim 1 is also valid for claim 1. Accordingly, claim 16 is allowable.

CONCLUSION

In view of the foregoing remarks, it is submitted that the claims as now appearing in this application are in good and proper form for allowance. A favorable action on the part of the examiner is respectfully solicited.

Respectfully submitted,



William R. Evans
c/o Ladas & Parry LLP
26 West 61st Street
New York, New York 10023
Reg. No. 25858
Tel. No. (212) 708-1930